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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/525,799 | 02/25/2005 | Daisuke Yamada | 266491US2PCT | 3014 |
| 22850 | 7590 | 03/08/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | ISLA RODAS, RICHARD | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2829 | |

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/525,799 | Applicant(s) YAMADA ET AL. | |
| | Examiner Richard Isla-Rodas | Art Unit 2829 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/23/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/25/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-10 and 12-14 in the reply filed on 01/23/2006 is acknowledged. The traversal is on the ground(s) that the PTO has not carried forward its burden of proof to establish that searching and examining both of the noted sets of claims would be an undue burden. This is not found persuasive because, as noted in the Election/Restriction requirement, Group I belongs in an area (324/754) different to that of Group II (29/848). They both have acquired a separate status in the art as shown by their different classification.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claim 1 is objected to because of the following informalities: The meaning of "*opening diameter of the mesh*" isn't clear. It's not clear whether it means the diameter (size) of the mesh or the diameter (size) of each hole in the mesh. For the purpose of examination, the limitation "opening diameter" will not be considered. Clarification is requested.

3. Claims 6 and 5 are objected to because they contradict the limitations in the independent claim. Namely "Particles exhibiting **neither conductivity nor magnetism**" whereas claim 1, states that **conductive** particles exhibiting **magnetism** are contained in the conductive path-forming parts.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the US Patent to Kimura et al. (6,720,787) in view of the US Patent to Rowlette (5,163,837).

In terms of claim 1, Kimura shows in Figure 16, an anisotropically conductive connector (10) comprising an anisotropically conductive film (12), in which a plurality of conductive path-forming parts (11) each extending in a thickness-wise direction of the film are arranged in a state mutually insulated by insulating parts, wherein the anisotropically conductive film is formed by an insulating elastic polymeric substance (Column 1, line 60), conductive particles (P), exhibiting magnetism are contained in the conductive path-forming parts. Kimura et al. teach all of the claimed elements as discussed above, except for a reinforcing material formed of insulating mesh contained in a surface layer portion on one surface side of the anisotropically conductive film. Rowlette teaches in Figure 4, a reinforced material formed of insulating mesh (34) used to reinforce a connector. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teaching of reinforcing mesh disclosed

Art Unit: 2829

by Rowlette to reinforce the anisotropically conductive film in Kimura et al. in order to provide flexible reinforcement to the anisotropically conductive layer.

In terms of claim 4, Kimura et al. shows in Figure 16, a supporting body (15) for supporting a peripheral edge portion of the anisotropically conductive film.

In terms of claim 5, Kimura et al. teaches in claim 8, that the anisotropically conductive connector serves as an electrical connection between electrodes to be inspected of a circuit device, which is an object of inspection, and inspection electrodes of a circuit board for inspection by being intervened between the circuit device and the circuit board for inspection, wherein a reinforcing material formed of insulating mesh or nonwoven fabric is contained in a surface layer portion, with which the circuit device comes into contact, on one surface side of the anisotropically conductive film (See column 28, lines 33-43).

As to claims 8, 9 and 10, it has been held in Court that the manner of operating a device does not differentiate an apparatus claim from the prior art.

As mentioned in regards to claim 1, Kimura et al. shows in Figure 16, an anisotropically conductive connector (10) comprising an anisotropically conductive film (12), in which **a plurality of conductive path-forming parts (11) each extending in a thickness-wise direction of the film are arranged in a state mutually insulated by insulating parts**, wherein the anisotropically conductive film is formed by an insulating elastic polymeric substance (Column 1, line 60), conductive particles (PP exhibiting magnetism are contained in the conductive path-forming parts. The manner of operating the device, in this case,

Art Unit: 2829

the choice of connecting the conductive path-forming parts to electrodes-to-be-inspected or to not connect them to electrodes-to-be-inspected, does not differentiate the claimed apparatus from that of Kimura et al. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

As to claim 12, in addition to that stated with regards to claim 5, Kimura et al. shows in Figure 14, an inspection apparatus for circuit devices, comprising a circuit board (20) for inspection having inspection electrodes (21) arranged correspondingly to electrodes to be inspected (7) of a circuit device (5), which is an object of inspection and an anisotropically conductive connector (65b) arranged on the circuit board for inspection.

As to claim 13, Kimura et al. shows in Figure 16, a “*pressurizing force-relaxing*” frame arranged between the circuit device (15) which is the object of inspection and the anisotropically conductive connector (65b). See column 19, line 53.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents to Kashiro et al. (4,209,481), Lee et al. (4,778,950), Caillat et al. (6,453,553), Kokubo et al. (6,969,622), and the US Patent Application Publication by Kimura et al. (2002/0060583).

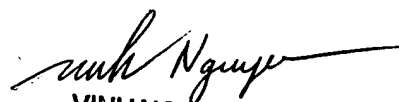
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Isla-Rodas whose telephone number is (571) 272-5056. The examiner can normally be reached on Monday through Friday 8 am to 4:30 pm.

Art Unit: 2829

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard Isla-Rodas


VINH NGUYEN
PRIMARY EXAMINER
A-4-2829
03/06/06